

REMARKS

Applicant has carefully studied the Office Action of 05 September 2003 and offers the following remarks to accompany the above amendments. Applicant appreciates the telephonic interview of 04 December 2003 at which time this amendment was discussed. Where appropriate, comments from the telephonic interview are included.

Initially, Applicant amends independent claims 1, 17, 20, and 23 to recite that the profile is a user-desired profile. Applicant amends claim 13 to conform to the amendment to claim 1. Support for this amendment can be found at page 3, lines 10-11 and does not constitute new matter.

Claims 1-7 and 11-23 were rejected under 35 U.S.C. § 103 as being unpatentable over Amin et al. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every element is taught or suggested in the references. MPEP § 2143.03. The Patent Office admits that Amin et al. does not teach the profile (see Office Action, p. 3, lines 1-2), but then explains that Amin et al. does evaluate demographic and other related criteria, pointing to col. 4, lines 3-28 of Amin et al. The Patent Office opines that this database 80 that has the demographic information is analogous to a profile. During the telephonic interview, the Examiner reiterated that this demographic information was used to determine event criteria and location criteria such that information was sent to the users.

As amended, the claims recite that the profile is a user-desired profile. Nothing in Amin et al. teaches or discloses this element. As presented to the Examiner during the telephonic interview, Amin et al. follows a push model for delivering information to the user (see title). Specifically, the user fills out the survey and the companies corresponding to the localities described in the reference determine, based on the information in the survey, if they wish to send notices to the user. The user, after filling out the survey, has no choice in the matter as to whether he receives the information. That is, once the company decides to send the information to the user, the user has no ability to block the information, and thus the user may receive the information at an inappropriate time (such as while they are at work) or at an inappropriate location. The reference's approach can be seen, *inter alia*, at col. 2, lines 5-6, col. 3, lines 12-16 and 24-26.

In contrast, the claims, as amended, recite that the user desires the profile and that the profile defines event criteria and location criteria which must correlate with an event occurrence and location indicia before the information is sent to the user. This approach is the opposite of what is taught and suggested in Amin et al. The goal of the reference is to push content to the user and thus, the content providers do not want the user to have control over what sort of information is sent to him. Thus, the reference actually encourages the removal of profile creation powers from the users.

When this distinction was presented during the telephonic interview, the Examiner indicated that he felt the claim was "too short" and that the profile was "too broad." Applicant respectfully submits that length and breadth of a claim does not *per se* establish obviousness. If length or breadth of the subject claim is the basis for the rejection under an obviousness determination, Applicant respectfully submits that such a basis for a rejection is improper, and the obviousness rejection should be withdrawn. Obviousness is only established through a showing that the reference teaches or suggests all the claim elements. MPEP § 2143.03. In this particular instance, the Patent Office has not been able to support the position that the user-desired profile is taught or suggested in the reference as required under MPEP § 2143.03. Unless the Patent Office can articulate a reason why the references of record would be modified to include a user-desired profile that defines event criteria and location criteria that are correlated to an event occurrence and location indicia prior to sending content to the user, the reference does not establish *prima facie* obviousness and the claims are allowable over the rejection of record.

Applicant also separately argues claim 13. In its analysis of claim 13, the Patent Office opines that Amin et al. discloses the "user requesting the location information through a computer/hand-held mobile, webpage, email system as desired" and points to col. 1, line 45-col. 2, line 20 and col. 3, lines 7-47. A user requesting information through a particular device is not the same thing as the recited user-created profile, nor would someone of ordinary skill in the art consider them to be the same thing. To this extent, the citation provided by the Office Action is not germane to the inquiry. More relevant is the passage at col. 4, lines 20-22 of Amin et al., which indicates that a user provides survey information which is stored as part of the demographic database. While the user may fill out the survey, the user does not create the profile with the survey, and thus, even this passage does not teach or suggest the claim element. In fact, the arrangement of the reference actually teaches away from the claim element. In the

case of the claim element, the user creates the profile. In the case of the reference, the goal of the reference is to push content to the user and thus, the content providers do not want the user to have control over what sort of information is sent to him. Thus, the reference actually encourages the removal of profile creation powers from the users.

Since the reference does not teach or suggest a claim element, and in fact, teaches away from the claim element, the Patent Office has not established *prima facie* obviousness with respect to the independent claims. Thus, the independent claims define over the rejection of record. Since the independent claims define over the rejection of record, the dependent claims likewise define over the rejection of record for at least the same reasons.

Claims 8-10 were rejected under 35 U.S.C. § 103 as being unpatentable over Amin et al. in view of Asaoka et al. Applicant respectfully traverses. The standard for obviousness is set forth above. As explained above, Amin et al. does not teach or suggest the user-desired profile. Nothing in Asaoka et al. cures this deficiency. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination of references does not teach or suggest the claim element, the Patent Office has not established *prima facie* obviousness, and the claims are in a condition for allowance.

Applicant requests reconsideration of the rejection in light of the amendments and arguments presented herein. The references of record do not teach or suggest the user-desired profile. Applicant requests claim allowance at the Examiner's earliest convenience.

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Respectfully submitted,

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